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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,028	09/29/2000	Toshikatsu Tsukamoto	32739M037	2581

7590 05/02/2005

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EXAMINER	
PARK, CHAN S	
ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/672,028	TSUKAMOTO, TOSHIKATSU	
	Examiner	Art Unit	
	CHAN S PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/18/05 has been entered.

Response to Amendment

2. Applicant's amendment was received on 1/18/05, and has been entered and made of record. Currently, **claims 1-3 and 5** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1-3 and 5** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morisawa et al. U.S. Patent No. 5,881,214 (hereinafter Morisawa) in view of Melen U.S. Patent No. 6,426,806.

4. With respect to claim 1, *as cited in the previous Office action dated 10/18/04*, Morisawa discloses an image output apparatus, comprising:

an image reading section for (image reading unit 25 in fig. 11) reading an image on a document and converting the image into image data (col. 7, lines 18-42);

an image storing section (optical magnetic disk storage unit 21) for storing the image data read by the image reading section;

an image output section (image printing unit 27) for outputting the image corresponding to the document on the basis of the image data stored in the image storing section (col. 6, lines 33-36);

an index sheet issue instruction accepting section (keyboard 15) for accepting an instruction to issue the index sheet;

an index sheet output control circuit (image printing unit 27) for causing the image output section to output an index sheet in response to the acceptance of the instruction to issue the index sheet by the index sheet issue instruction accepting

section, the index sheet output by the image output section carrying index information (fig. 7 & col. 6, lines 12-37);

an index recognizing circuit (CPU 11 in conjunction with RAM 300 in col. 2, lines 63-64 and S4 in fig. 12) for image-recognizing, when the index sheet (marking sheet 400) is read by the image reading section, the index information on the sheet (bar codes 403-405 in figs. 5 & 6);

an index registering circuit for registering the index information recognized by the index recognizing circuit and corresponding storage area designation information for designating a storage area (a particular disk among a plurality of disks) in said image storage section, associated with each other (col. 5, lines 32-38); and

a circuit for storing image data representing a document, which has been read by the image reading section subsequently to the index sheet (fig. 11), in a storage area of the image storing section designated by storage area designation information associated with the index information (col. 7, line 55 – col. 8, line 57), the index sheet having been output by the image output section under control of the index sheet output control circuit (fig. 7).

The image output apparatus of Morisawa reads and decodes the index information (disk ID code and the index image ID code represented by the bar codes in S4 of fig. 12) and documents subsequent to the index sheet (mark sheet in fig. 11) is scanned and stored in the disk (storage area) defined by the bar codes (S13). Note that if the optical disk (storage area) in the apparatus is different from the disk defined by the bar codes then the whole scanning operation is terminated (S14). Therefore, the

claimed index information is equivalent to the bar codes since they identify the optical magnetic storage for storing the scanned document (col. 9, lines 58-60) and marking operation is thus, unnecessary at least for defining the storage area in the scanning mode.

Note that the bar code 404 represents/defines a particular disk or a storage area among other disks or storage areas (col. 5, lines 32-38).

Moreover, an index sheet issue instruction accepting section is an inherent feature in the Morisawa apparatus since there must be a command key to generate the marking sheet.

Morisawa, however, does not disclose expressly *an index information storing section arranged to store an index registration table*.

Melen, the same field of endeavor of the index sheet reading apparatus, discloses an image processing apparatus, comprising:

an image reading section (scanner 106) for reading an image on a document and converting the image into image data (fig. 1);

an image storing section for storing the image data read by the image reading section (col. 3, lines 13-16 & col. 3, line 60 – col. 4, line 5);

an index recognizing circuit for image-recognizing, when an index sheet (control sheet 102) is read by the image reading section, the index information on the sheet (col. 2, lines 38-63);

an index information storing section arranged to store an index registration table (document identifier 126 in conjunction with location information 120 in col. 3, lines 1-3);

an index registering circuit for registering, in response to image recognition by the index recognizing circuit, the index information recognized by the index recognizing circuit and corresponding storage area designation information for designating a storage area in said image storing section, associated with each other in the index registration table, the index registering circuit generating the storage area designation information upon the image recognition of the index information by the image recognizing circuit (col. 2, line 64 – col. 3, line 12); and

a circuit for storing image data representing a document, which has been read by the image reading section subsequently to the index sheet (col. 2, lines 30-37), in a storage area of the image storing section designated by storage area designation information associated with the index information, the index sheet having been output by the image output section under control of the index sheet output control circuit (col. 2, line 64 – col. 3, line 12 & col. 3, line 60 – col. 4, line 5).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the image scanning and storing device of Melen into the image output apparatus of Morisawa.

The suggestion/motivation for doing so would have been to store the image data in a particular location using the identifier included in the index sheet (col. 3, lines 1-12 & col. 4, lines 6-22 of Melen).

Therefore, it would have been obvious to combine Morisawa with Melen to obtain the invention as specified in claim 1.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Morisawa (hereinafter reference 1) and Melen as applied to claim 1 above, and further in view of Morisawa U.S. Patent No. 5,933,548 (hereinafter reference 2).

5. With respect to claim 2, the combination of reference 1 and Melen discloses the image output apparatus according to claim 1, but it does not disclose expressly a circuit for overwriting.

Reference 2, the same field of endeavor of marking sheet in the image output apparatus, discloses a circuit for overwriting, when the index information recognized by said index recognizing circuit has already been registered by said index registering circuit, an image data representing a document which has been read by said image reading section subsequently to the index sheet on the storage area, in said image storing section which is to be designated by the storage area designation information associated with the index information (col. 8, lines 7-17).

Further, overwriting newly obtained data to an already occupied memory space is a well-known method in memory management art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the overwriting or updating method taught by reference 2 to the method of storing a plurality of print data in designated memory area of reference 1.

The suggestion/motivation for doing so would have been to efficiently update the newly obtained print data in the same memory area.

Therefore, it would have been obvious to combine two references to obtain the invention as specified in claim 2.

6. With respect to claim 3, the combination of reference 1 and Melen discloses the image output apparatus according to claim 1, but it does not disclose expressly an index image output instruction accepting section for accepting an index image output instruction for outputting a document image corresponding to an index information carried on an index sheet, and an index image output control circuit for reading out, when said index recognizing circuit recognizes the index information in a state where the index image output instruction is accepted by the index image output instruction accepting section, the image data, in said image storing section, to be designated by the storage area designation information associated with the recognized index information, and causing the image output section to output the image corresponding to the image data.

Reference 2, the same field of endeavor of marking sheet in the image output apparatus, discloses an index image output instruction accepting section for accepting an index image output instruction for outputting a document image corresponding to an index information carried on an index sheet, and an index image output control circuit for reading out, when said index recognizing circuit recognizes the index information in a state where the index image output instruction is accepted by the index image output instruction accepting section, the image data, in said image storing section, to be designated by the storage area designation information associated with the recognized

index information, and causing the image output section to output the image corresponding to the image data (col. 8, lines 53-62).

The cited column teaches that an analysis program for the group index registration gets an output instruction for printing out the stored image data.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the printing method taught by reference 2 with the method of storing a plurality of print data in designated or registered memory area of reference 1.

The suggestion/motivation for doing so would have been to efficiently print out the image data that are previously stored under the index sheet.

Therefore, it would have been obvious to combine two references to obtain the invention as specified in claim 3.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over references 1 & 2 and Melon as applied to claim 3 above, and further in view of Machino et al. Japanese Patent Publication No. 09-221263 (hereinafter Machino).

7. With respect to claim 5, the combination of references 1 & 2 and Melen discloses the image output apparatus according to claim 3, wherein the image output section outputs and records an image of a document on a recording sheet (col. 6, lines 33-36 of reference 1).

The combination, however, does not disclose expressly that the index image output control circuit causes the image output section to discharge recording sheets to different positions for image data of respective documents.

Machino, the same field of endeavor of image printing device, discloses an image output apparatus comprising an image output control section for discharging recording sheets to different trays for image data of respective documents (SOLUTION section of the Abstract).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the paper discharging apparatus of Machino into the marking sheet recognizing apparatus of references 1 & 2.

The suggestion/motivation for doing so would have been to provide an apparatus that separates each print jobs so that each job can be distinguished from each other.

Therefore, it would have been obvious to combine references 1 & 2 with Machino to obtain the invention as specified in claim 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
April 25, 2005

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